



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,394	09/08/2003	William J. Mertz	1248 P 122	9357

7590 05/02/2007
MCDERMOTT, WILL & EMERY LLP
227 WEST MONROE STREET
CHICAGO, IL 60606-5096

EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
----------	--------------

1712

MAIL DATE	DELIVERY MODE
-----------	---------------

05/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/657,394	Applicant(s) MERTZ ET AL.	
	Examiner Margaret G. Moore	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1712

1. Claims 1 to 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have amended claim 1 to state that "... the coating being cured with heating...". This language indicates that the coating is cured by means of heating. However, since the coating is defined as being radiation curable, it is unclear how the coating is cured. This is particularly true in new claims 13 and 15, which indicated that the coating is cured by means of high velocity air. This contradicts claims 12 and 15 which include the language "being cured with heating" as well as referring to the composition as radiation curable. Clarification is required.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 to 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Leir et al. '356.

The rationale behind this rejection has been detailed in previous office actions and as such this will not be repeated. Applicants' traversal is not persuasive.

Applicants state that Leir prepares a coating with solvent but without heating. It is noted, though, that examples such as Example 33 and Example 34 do, in fact, heat the compositions. See for instance Example 34 which exposes the coating to air of 187° C (368° F) (column 16, line 50). While this is termed a "solventless" composition, note that a reactive diluent is present. This can be considered an organic solvent. In response to applicants' comments that the reactive diluent is intended to remain in the composition after heating, this has nothing to do with the fact that the heating step in Leir et al. would be expected to result in the same total *silicone extractable* content as the heating step in the preparation of the claimed release liner.

It is unclear why applicants would believe that their step of heating, for instance to a temperature of at least 200° F, would result in an inherently different final product than the prior art that heats to 368° F. Note too that the air is supplied by a hot air

blower, which indicates the added use of high velocity air to further, inherently drive off any volatile compounds. This heating occurs prior to the UV cure.

Again, while the exact silicone extractable content is not taught, it would appear to be inherently found in the final release composition of Leir et al. since the process by which the final compositions are made is the same.

The Examiner acknowledges applicants' Declaration in which they clarify the comparison composition in the specification. This does not, however, help in overcoming the rejection since the prior art shows heating and forced air and does not rely only on what applicants term "passive evaporation".

Thus, what applicants argue is not shown in Leir et al. is, in fact, shown. The results of the heating step in the preparation of the claimed release liner would then be expected to be the same in the preparation of the prior art release liner.

The Examiner notes that in the office action dated 4/26/06 and 11/10/05, the "solventless" examples such as Ex. 33 and 35 were noted. Applicants' response has not addressed these examples, but are directed to the "passive evaporation" processes.

4. As an aside, please note the following. In an effort to provide a thorough examination, the Examiner reviewed and updated the prior art search for this application. In this search she broadened the focus beyond the process by which the release liner was formed (as is the basis for the rejection above). With this in mind, please note Eckberg et al. '480. This reference teaches the preparation of epoxysilicone that can be used in release coatings (column 6, line 51). In making the epoxysilicones, the final product is subjected to devolatilization to remove low molecular weight linear and cyclic siloxanes. In fact, this reference teaches heating the composition to as high as 250°C to remove these volatile compounds as well as reduced pressure (column 6, line 20 and on). It would appear that release liners prepared from these epoxysilicones will inherently meet the claimed requirement of silicone extractables. The only difference is that heating occurs prior to coating rather than after but this would not be expected to result in a different final product. See also Eckberg et al. '453 which uses the epoxysilicones

of '480 in release coatings. The Examiner has opted not to make a prior art rejection over these references at this time since the rejection over Leir et al. is still applicable.

Manzouji et al. is also cited as being of general interest. This teaches silicone release compositions and teaches complete removal of the solvent by heat treatment prior to UV cure (column 8, line 56).

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1712

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
4/30/07